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07/23/2002

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EXAMINER

PESELEV, ELLI

ART UNIT

PAPER NUMBER

1623

DATE MAILED: 07/23/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- ☒ Responsive to communication(s) filed on 7/2/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-79 is/are pending in the application.
- Of the above claim(s) 41-43 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-40 and 44-79 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 3
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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Claims 41-43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made without traverse in Paper No. 8.

Claims 1-40 and 44-79 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating gram positive bacterial infections with a combination of antibiotic and an antibiotic potentiator having chemical formulas (I), (II), (III), (IV) and (V), does not reasonably provide enablement for the treatment of gram negative bacteria with a potentiator broadly described as acyl hydrazide, oxy amide or 8-hydroxy quinoline. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Since the terms acyl hydrazide, oxy amide and 8-hydroxy quinoline encompass such a broad class of compounds, it would take an undue amount of experimentation to determine which specific compounds are useful in the instant invention.

Claims 1-13, 28-40 and 44-77 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is not clear from claim 1 how the bactericidal action of an antibacterial agent is increased when the claim is directed to the administration of an antibiotic potentiator in the absence of a bacterial agent.

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The composition claims 28-40 are substantial duplicates of composition claims 44-77.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Abbruzzese et al (U.S. Patent No. 4,058,613).

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Abbruzzese et al disclose that 8-hydroxy quinoline has antibacterial activity (column 1, lines 6-11). The claimed method of contacting bacterium with 8-hydroxy-quinoline is anticipated by Abbruzzese et al.

Claims 1-40 and 44-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abbruzzese et al (U.S. Patent No. 4,058,613) in combination with Pfaller et al (Antimicrobial Agents and Chemotherapy, July 1988, p. 1762-1770).

Abbruzzese et al disclose that 8-hydroxy quinoline has antibacterial activity but do not disclose the same in combination with additional antibiotics. However, since Pfaller et al disclose the activity of various antibiotics in Table 3, page 1765, a person having ordinary skill in the art at the time the instant invention was made would have been motivated to combine 8-hydroxy quinoline with additional antibiotics because such a person would have expected the resulting composition to be useful in treating bacterial infections.


The information disclosure statement filed 6-17-02 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Note that copies of the references cited have not been received.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elli Peselev whose telephone number is 703-308-4616. The examiner can normally be reached on weekdays from 8.30 a.m. to 5.00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter, can be reached on (703) 308-4532. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
**ELLI PESELEV**  
**PRIMARY EXAMINER**  
**GROUP 1200**